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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/716,890	11/20/2000	David N. S. Hon	460-001 Cont.IV	5003

22465 7590 10/21/2003

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EXAMINER

PATTEN, PATRICIA A

ART UNIT	PAPER NUMBER
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1654

DATE MAILED: 10/21/2003

45

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/716,890

Applicant(s)

HON ET AL.

Examiner

Patricia A Patten

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-34 is/are pending in the application.
- 4a) Of the above claim(s) 32-34 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28 and 30-31 is/are allowed.
- 6) ☒ Claim(s) 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Claims 29-34 are pending in the application.

Newly submitted claims 32-33 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions employ different compositions which would necessarily bring about a different effect when administered to an individual. For example, the methods of claims 28-31 employ particular amounts of zinc, calcium and rubidium ions, while the composition of claims 32-34 do not contain rubidium or the particularly claimed amounts as seen in claims 28-31. The search for each of the above inventions would not be co-extensive particularly with regard to the literature search. Further, a reference which would anticipate the invention of one group would not necessarily anticipate or even make obvious another group.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 32-33 have hereby been withdrawn from

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consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Terminal Disclaimer

The terminal disclaimer filed on 7/28/03 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent number 6,149,947 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Trademarks

The use of the trademark WHITFIELD'S and BENCELOK are still noted in this application. Although Applicant has amended the Specification to read 'Whitfield and Bencelok are trademarks for pharmaceutical ointments', the trademarks should nevertheless be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

Claim 29 remains rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 29 is drawn to wherein the composition of claim 28 comprises from 40% to 80% by weight of solids extracted from oak bark. This claim has been interpreted to mean that the composition of claim 28 is a 40-80% oak bark extract.

As indicated in the previous Office Action, there is no indication within the Instant specification that an aqueous extract of oak bark (40-80%) would coincide with the parts by weight of ions as recited in claim 28. On the contrary, Table 2 describes the concentrations in ppm of individual elements up to 40%. Even assuming that the parts in Claim 28 were drawn to parts per million (ppm) (claim 28 is actually drawn to parts by weight of inorganic solids), calculations of the individual elements at 40% concentration (Table 2) conclude that they do not coincide with the parts as recited in claim 2 in parts

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per million. Further, the Examiner cannot extrapolate to 80% concentration of the oak bark extract to determine the ppm of the ions in the extract because the data points are not linear, and some points are outliers (please see Appendix A attached to the previous Office Action).

Thus, although it is clearly disclosed that the particular ranges of ions were produced synthetically by Applicants, it does not appear that Applicants were in possession of an *extract of oak bark* which actually possessed the claimed ranges of ions.

Because this claim, interpreted in its broadest sense can mean that the composition is an extract of oak bark, the claim stands rejected for the reasoning set forth in the previous Office Action. Applicants did not present specific arguments toward this rejection, although it is thought that Applicants intended to overcome this rejection via the most recent amendment. However, as stated *supra*, the amendment to the claims can still be drawn to wherein the composition of claim 28 is an extract of oak bark.

Claim 29 remains rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 29 newly recites 'wherein the composition comprises from 40% to 80% by weight of solids extracted from oak bark'. This phrase is still considered confusing in that it is not known if Applicants intend for this to mean that the recited composition in claim 28 *further* comprises the solids from an aqueous oak bark extract, or wherein the composition as recited in claim 28 *is* an oak bark extract.

Allowable Subject Matter

Claims 28, 30 and 31 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia A Patten whose telephone number is (703) 308-1189. The examiner can normally be reached on 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on (703) 306-3220. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Patricia A Patten
Examiner
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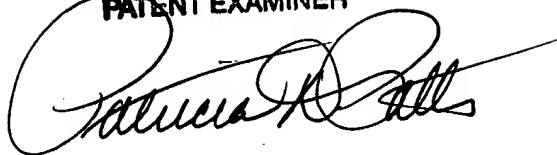
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PATRICIA PATTEN
PATENT EXAMINER

A handwritten signature in black ink, appearing to read "Patricia Patten", written over the printed name and title.